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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/928,074 09/11/97 FISH

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HM21/0904

EXAMINER

HAYES, R

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

09/04/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/928074

Applicant(s)

O'Brien

Examiner

Hayes

Group Art Unit

1645

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-31 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-31 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1645

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to prosaposin receptor agonists and pharmaceutical compositions thereof, classified in class 514, subclass 14.
  - II. Claims 9-21, drawn to methods of alleviating neuropathic pain in a subject, classified in class 424, subclass 85.1.
  - III. Claims 22-31, drawn to methods of treating neuronal tissue (i.e., as it relates to motor and sensory neurons) comprising administering prosaposin derivatives, classified in Class 514, subclass 2.
  - IV. Claims 22-25, drawn to methods of treating neural tissue (i.e., as it relates to oligodendrocytes/myelination/demyelination) comprising administering prosaposin derivatives, classified in Class 514, subclass 2.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I and II-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the peptides/agonists of Group I can be used in other materially

Art Unit: 1645

different methods, such as in affinity chromatography, or to generate antibodies. In contrast, the methods of treatment using prosaposin receptor agonists require appropriate neural cell populations, subjects and disease states to treat, which are not required in Group I.

Although there are no provisions under the section for "Relation of Inventions" in MPEP 806.05 for inventive groups that are directed to different methods; restriction is deemed proper because these methods appear to constitute patently distinct inventions for the following reason:

Groups II-IV are drawn to distinct methods which differ in the method objectives, method steps, and in the populations of neural cell types to be treated. The invention of Group II is drawn to a method of treating neuropathic pain, versus the method of Group III which is directed to affecting motor or sensory neuronal survival, versus the method of Group IV which is directed to treating glial cells involved in myelination. These inventions are, therefore, patentably distinct, since one is not required for the other.

3. Because these inventions are distinct for the reasons given above, they have acquired a separate status in the art as shown by their different classification, and the non-coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider all the separable groups with their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Application/Control Number: 08/928074

Art Unit: 1645

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.  
September 3, 1998



PATRICIA A. DUFFY  
PRIMARY EXAMINER